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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,786	06/15/2001	Gabriel L. Romero	1003-0559	9984

7590 12/31/2002
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EXAMINER

ODA, CHRISTINE K

ART UNIT PAPER NUMBER

2858

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,786

Applicant(s)

Romero, Schmitz & Paulsen

Examiner

Christine K. Oda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 16, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) 8-10 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 11-16 is/are rejected.
- 7) ☒ Claim(s) 7 and 17 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 10, 2002 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Part III. DETAILED ACTION***ELECTION/RESTRICTION***

1. Applicant's election of Species IA in Paper No. 8 (dated October 10, 2002) is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse, M.P.E.P. §818.03(a). Thus Claims 1-7 and 11-17 will be examined. Claims 8-10 and 18-20 are withdrawn from consideration as being drawn to a non-elected invention, 37 C.F.R. §1.142(b).

INFORMALITIES

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

SPECIFICATION

3. The disclosure is objected to because of the following informalities:
- A. If WINTHRAX on pp. 11-5 is a trademark. It should be entirely capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks, M.P.E.P. 608.01(v).

Appropriate correction is required.

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CLAIM OBJECTIONS

Although Applicant's Claim(s) meet the requirement of 35 U.S.C. §112 second paragraph, i.e. the metes and bounds are determinable, the use of terminology could be improved.

- 5 4. Claims 5 and 15 are objected to under 37 C.F.R. §1.75, because of the following informalities:

A. With respect to Claims 5 and 15, "a user" should be --the user--.

- It is in the best interest of the patent community that applicant, in his/her normal review and/or rewriting of the claims, to take into consideration these editorial situations
10 and make changes as necessary. Appropriate correction is required.

CLAIM REJECTIONS - 35 U.S.C. §103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- 15 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 and 1-14, are rejected under 35 U.S.C. §103(a) as being unpatentable
20 over Nihart (4,941,115) in view of Asprey (5,299,306).

- A. With respect to Claims 1 and 11, Nihart teaches a hand held tester connecting a host device and a target device, considered to be the input/output ports of a DP system, such as peripheral devices to a central processor, the claimed impedances, considered to be a balun (Col. 4, lines 6-10). Nihart teaches
25 connectors, but lacks the cables. Asprey teaches that it is well known to use terminals/extender cable lengths with an impedance matching network (Col. 12, lines 5-15). One of ordinary skill in the art would have readily recognized the advantage and desirability to use cables in order to achieve critical dampening in some systems and devices.

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B. With respect to Claims 2 and 12, Nihart further teases at least one signal measurement connector (#221 and #222).

C. With respect to Claims 3 and 13, Nihart teaches a system wherein a controller supervises the transfer of data to and from multiple I/O devices, considered to be a server (Col. 2, lines 10-15).

D. With respect to Claims 4 and 14, Nihart teaches a storage controller controlling multiple disk drives, considered to be a disk sub-system (Col. 2, line 14-15).

6. Claim 5 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nihart (4,941,115) and Asprey (5,299,306) as applied to Claims 1 and 11 above, and further in view of Sturm, Jr. (3,571,752).

A. With respect to Claims 5 and 15, Nihart and Asprey lack a switch. Sturm, Jr. teaches that it is well known to use a switch (#28) to select various impedances (Col. 4, lines 6-12). one of ordinary skill in the art would have readily recognized the advantage and desirability to use a switch in order to have the user directly control the setting depending upon the user's wants and needs according to the situation involved. Also, to use a manual means accomplishes the same result.

7. Claim 6 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nihart (4,941,115) and Asprey (5,299,306) as applied to Claims 1 and 11 above, and further in view of, and further in view of Wallace (5,926,031).

A. With respect to Claims 6 and 16, Nihart teaches using the testing instrument between a CPU and work stations, printers, etc. (Fig. 1). Wallace teaches that impedance matching for SCSI standards is important. One of ordinary skill in the art would have readily recognized the advantage and desirability to test the impedance matching regarding SCSI in order to reflections may cause data or address errors on the bus with digital ones being read as zeros, or vice versa (Col. 1, lines 17-19).

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8. Claims 7 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

CONTACT INFORMATION

5 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine K. Oda whose telephone number is (703) 305-3857. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, N. Le, can be reached on (703) 308-0750.

10 Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0956. The Technology Center 2800 Customer Service Center can be reached at (703) 306-3329.

15 The 2800 Technology Center facsimile number for FILING Technology Center 2800 PAPERS ONLY is available at (703) 308-7722, (703) 308-7724 or (703) 872-9318. An after final facsimile number for FILING Technology Center 2800 AFTER FINAL PAPERS ONLY is available at (703) 872-9317.

CKO: cko
23 December 2002

Christine K. Oda
Christine K. Oda
Primary Examiner
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